

REMARKS

The Final Office Action mailed February 18, 2010 has been reviewed and carefully considered. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1-20 are pending in this application. Independent claims 1, 8 and 14 have been amended. No new matter has been added.

§103 REJECTIONS

Claims 1-14 and 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski (US 2006/0161956) in view of U.S. Patent Application No. 2009/0044226 to Ellis et al. (hereinafter Ellis '226). Applicant respectfully disagrees with the rejections. However, Applicant has made further clarifying amendments to the independent claims, namely to specify wherein the reminder customizer includes a reminder options feature for enabling the user to simultaneously indicate at least one of a plurality of devices on which the reminder is designated to appear which is not capable of receiving the broadcast programming event, and at least one device which is capable of receiving the broadcast programming event.

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish

Ser. No. 10/591,376

PU040072

CUSTOMER NO. 24498

Amendment dated: May 10, 2010

Reply to Final Office action of February 18, 2010

prima facie obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Wasilewski involves a system and method for managing user-defined settings, such as reminder messages for reminding the user of upcoming television programs, in a television system. Reminder messages are scheduled by the user via a first digital home communication terminal (DHCT or set top box) which transmits a reminder request to a second DHCT.

Wasilewski discusses wherein a user may designate one or more locations where a reminder may be provided for a television program. Paragraph [0110] recites:

"A user may selection option 803 to schedule a reminder that is to be provided by a DHCT (e.g., DHCT 200-1) that is driving the television that the user is currently viewing. A user may alternatively select option 802 in order to schedule a reminder that is to be provided by another DHCT (e.g., DHCT 200-2) located remotely or at the customer premises (i.e., a DHCT that is not driving the television that the user is currently viewing). **If the user desires that a reminder be provided at more than one location (e.g., via DHCT 200-1 and DHCT 200-2), then the user may select option 804 which results in a reminder being provided by a plurality of DHCTs located at the customer premises.** Alternatively, the user may enter identification information for each respective DHCT 200 for which the user wishes to transmit the reminder or applicable information."

[emphasis added]

The Examiner argues that Wasilewski discloses enabling the user to select at least one device on which the reminder is to appear which is not capable of receiving the broadcast

event and at least one device which is capable of receiving the broadcast programming event, and cites paragraph [0030] and FIG. 8. However, Applicant respectfully maintains that the cited paragraph [0030] and FIG. 8 merely generally mentions a method of transferring DHCT (digital home communication terminal) settings, namely from amongst DHCT devices.

The Examiner cites FIG. 8 in Wasilewski as teaching wherein a user is allowed to designate one or more locations where a reminder may be provided for a television program, and cites paragraph [0030] as teaching wherein a user may be able to receive program reminders via a device that is not a DHCT.

However, Wasilewski in FIG. 8 merely shows wherein a user can select amongst various set top boxes only ("this set top; other set top; or all set tops"). There is no provision or suggestion of a reminder options feature which enables the user to actively indicate a device which is NOT capable of receiving the broadcast programming event, much less a reminder options feature which enables a user to simultaneously indicate a device which can receive the programming event and one which cannot receive the programming event, essentially as presently claimed.

As far as paragraph [0030], Wasilewski simply generally mentions that: "...a user may be able to receive DHCT settings (e.g., program reminders) via a device that is not a DHCT (e.g., via a personal computer)." In other words, Wasilewski simply implies wherein one **DHCT** may communicate its settings to another device which is not a DHCT. Again, paragraph [0030] recites, *inter alia*:

"...User defined settings may be transmitted by the DHCT 200-1 to the DHCT 200-2 via the headend 300-1 and the headend 300-2. The headends 300-1 and 300-2 may be coupled via a network 150, which may be, for example, the Internet. **In another embodiment, a user may be able to receive DHCT settings (e.g., program reminders) via a device that is not a DHCT (e.g., via a personal computer).**"

[emphasis added]

However, a system which simply describes wherein **one DHCT can communicate with and transmit information** to another DHCT **and perhaps other devices** (which may not be a DHCT) is not to be confused with a set top box which enables a user to directly and simultaneously indicate the desired set top box and **non-set top box** devices on which a reminder is to appear. Wasilewski does NOT disclose or suggest a set top box which has a reminder options feature configured to enable a user to directly and simultaneously indicate the desired set top and non set top box devices on which a reminder is to appear.

Namely, Wasilewski fails to disclose or suggest at least a reminder options feature for enabling the user to simultaneously indicate at least one of a plurality of devices on which the reminder is designated to appear which is not capable of receiving the broadcast programming event, and at least one device which is capable of receiving the broadcast programming event, essentially as claimed in claims 1, 8 and 14.

The Examiner maintains that Ellis '226 allegedly discloses the claimed 'auto-tune' feature. Regardless, Applicant respectfully submits that Ellis '226 fails to cure at least the above-mentioned deficiencies of Wasilewski. Ellis '226 teaches an interactive program guide system that allows a user to adjust the user setting of a plurality of program guides at different user television equipment devices within a household from a single location (set top box).

Ellis '226 mentions that a reminders feature may be provided allowing a user to set a reminder for a television program, which may be displayed on the user's TV screen just before the TV program is to be broadcast. Ellis '226 also discusses that the user may select desired program guide locations to which reminder are to be applied. However, such varied locations are program guide locations (i.e., set top box locations) **within a household only**. See paragraph [0010], reciting *inter alia*: "Each piece of user television equipment may be

located in a different part of the home..." and paragraph [0111] reciting *inter alia*: "If set reminder screen 350 is not cancelled, the user selects the program guide locations (i.e., the locations of the various user television equipment devices within the household) to which the adjustments are to be applied by selecting apply to all option 205, current location option 209, or by selecting the select locations option 206..."

Ellis '226 is silent with respect to enabling user to designate **non-TV** devices on which the reminder is to appear, and from this it follows that Ellis '226 cannot possibly be said to teach enabling a user to select both "TV" and "non-TV" devices on which a reminder is to appear, essentially as presently claimed.

Indeed, Ellis '226 fails to disclose or suggest at least a reminder options feature for enabling the user to simultaneously indicate at least one of a plurality of devices on which the reminder is designated to appear which is not capable of receiving the broadcast programming event, and at least one device which is capable of receiving the broadcast programming event, essentially as claimed in claims 1, 8 and 14.

Accordingly, claims 1, 8 and 14 are asserted to be patentable and nonobvious over Wasilewski and/or Ellis '226 for at least the reasons stated above. Claims 2-7, 9-13 and 15-17 depend from claims 1, 8 and 14, respectively. The dependent claims include the limitations of their respective independent claims and are therefore believed to be patentable and nonobvious for at least the reasons stated for claims 1, 8 and 14.

Claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski (US 2006/0161956) in view of Ellis '226 and further in view of Ellis et al. (US 2005/0235322), hereinafter Ellis '322. Claims 18-20 were rejected under 35 U.S.C.

103(a) as being unpatentable over Wasilewski (US 2006/0161956) in view of Ellis '226 and further in view of Knudson et al. (US 2008/0184313), hereinafter Knudson.

The rejection of claims 15 and 18-20 is based, in part, on the contention that Wasilewski and/or Ellis '226 disclose or suggest the features of claims 1, 8 and 14, from which such claims depend. However, it is clear that the combination of Wasilewski and/or Ellis '226 with Ellis '322 and/or Knudson is legally deficient, since, at the very least, as explained above, Wasilewski and/or Ellis '226 do not disclose or suggest the features of presently amended claims 1, 8 and 14 from which claims 15 and 18-20 depend.

Accordingly, withdrawal of all the rejections and early and favorable reconsideration of this application is respectfully requested.